

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed May 2, 2007 rejected claims 1 and 4-38. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1 and 4-38 are pending. More specifically, claims 1, 10, 17, 21, 24, 31, 34, and 37 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claim 37 is objected to because of alleged informalities. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1, 4-9, and 17-38 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). Claim 10 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Birdwell, et al.* (U.S. Patent No. 6,108,706). Claims 11-16 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Birdwell, et al.* (U.S. Patent No. 6,108,706), in further view of *Sahota* (U.S. Publication No. 2002/0010928). Claim 23 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Jeannin, et al.* (U.S. Publication No. 2002/0083469). These rejections are respectfully traversed.

II. Claim Objections

Claim 37 is objected to because of alleged informalities. In an effort to address the Examiner's concerns, claim 37 has been amended to recite "at least one particular media content instance." In view of this amendment, Applicant respectfully submits that the objection to claim 37 should be withdrawn.

III. Rejections Under 35 U.S.C. §112

The Office Action rejects claim 23 under 35 U.S.C. §112, First Paragraph as allegedly failing to comply with the written description requirement. Applicant respectfully submits that claim 23 is supported by the specification in at least one embodiment. The Office Action alleges that page 11, line 53 through page 12, line 3 only supports an inclusive restriction. However, the specification continues:

The above example is only one implementation of the numerous different ways in which the content control module 100 (FIG.1) can control the display of media content provided by one of the client devices 140 (FIG.1) in the subscriber television 110 (FIG. 1). It should be apparent to one of ordinary skill in the art that the implementations provided are only examples of ways in which the different embodiments of the present invention can be implemented.

In one embodiment, the aforementioned content restrictions provided by the content control module 100 could be restrictions that require the inclusion of certain media content and/or restrictions that require the exclusion of certain media content. ... Exclusive content

restrictions might require, in one implementation, that certain media content instances not be displayed in the advertisement area 500 when corresponding commercial media is displayed in the video area 510 of the screen display 530

See Specification, lines 4-19.

Therefore, since claim 23 is supported in at least in embodiment in the specification, Applicant respectfully submits that the rejection of claim 23 should be withdrawn.

IV. Rejections Under 35 U.S.C. §102(e)

A. Claims 1 and 4-9

The Office Action rejects claims 1 and 4-9 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 1, as amended, recites:

1. A method in a subscriber television system (STS), the method comprising the steps of:
providing a plurality of media content instances to be displayed to a subscriber;
providing at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances; and
enabling at least one exclusive content restriction responsive to a reception of the at least one trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger.

(Emphasis added).

Applicant respectfully submits that claim 1 is patentably distinct from the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Wine* does not disclose, teach, or suggest at least **providing at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances; and enabling at least one exclusive content restriction responsive to a reception of the at least one trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger**. Even if, assuming for the sake of argument, *Wine* discloses an inclusive content restriction, *Wine* fails to disclose providing at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances; and enabling at least one exclusive content restriction responsive to a reception of the at least one trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger. The Office Action has alleged that providing an inclusive content restriction is effectively providing an exclusive content restriction. Applicant respectfully submits that this conclusion is made by examining the

outcome of an inclusive restriction in a very specific example, while disregarding the elements of the claims used to achieve the outcome.

An inclusive content restriction is not equivalent to an exclusive content restriction. Certainly, *Wine* fails to disclose providing an exclusive trigger. The Office Action cites an example (see page 3 of the Office Action) in which “an advertisement for a user in France should be in French and not English.” *Wine*, paragraph [0046]. However, in the context of the application as a whole, this operates to include French advertisements and, not only to exclude English advertisements, but also to exclude Spanish advertisements, Portuguese advertisements, German advertisements, etc. There is no particular exclusion disclosed in *Wine*. For instance, claim 1 also requires providing a plurality of media content instances to be displayed. Using the reasoning of the Office Action, and assuming, for the sake of argument, the French advertisements to be the instances to be displayed, then an exclusive restriction would necessitate excluding certain French ads. Such a feature is not disclosed in *Wine*. Taking the application as a whole without reading statements out of context, and without using particular fact situations, *Wine* fails to disclose using an exclusive trigger to exclude particular content, while allowing all other content. Therefore, *Wine* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 4-9 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 4-9 contain all the features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377,

54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 4-9 are patentable over *Wine*, the rejection of claims 4-9 should be withdrawn and the claims allowed.

B. Claims 17-20

The Office Action rejects claims 17-20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 17, as amended, recites:

17. A method in a subscriber television system (STS), the method comprising the steps of:

inserting, within an available insertion area in at least one transport stream, at least one exclusive trigger having at least one content restriction, the at least one content restriction enabling the display of all content except for particular content, the particular content associated with the at least one exclusive trigger; and

distributing the at least one transport stream with the at least one exclusive trigger to a plurality of client devices.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 17 is patentably distinct over *Wine*. Therefore, *Wine* does not anticipate independent claim 17, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 17, as amended, is allowable over the cited references of record, dependent claims 18-20 (which depend from independent claim 17) are allowable as a matter of law for at least the reason that dependent claims 18-20 contain all the

features of independent claim 17. Therefore, since dependent claims 18-20 are patentable over *Wine*, the rejection of claims 18-20 should be withdrawn and the claims allowed.

C. Claims 21-23

The Office Action rejects claims 21-23 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 21, as amended, recites:

21. A method in a subscriber television system (STS), the method comprising the steps of:
providing a plurality of media content instances to be displayed to a subscriber, a first media content instance of the plurality of media content instances comprising a video stream and a second media content instance of the plurality of media content instances comprising a particular advertisement;
providing at least one exclusive trigger synchronized with a priority event in the video stream; and
enabling display of all media content instances, while excepting the particular advertisement from being displayed simultaneously with the priority event in the video stream, the particular advertisement associated with the at least one exclusive trigger.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 21 is patentably distinct from the cited art. Therefore, *Wine* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over the cited references of record, dependent claims 22 and 23 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22 and 23 contain all

the features of independent claim 21. Therefore, since dependent claims 22 and 23 are patentable over *Wine*, the rejection of claims 22 and 23 should be withdrawn and the claims allowed.

D. Claims 24-30

The Office Action rejects claims 24-30 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 24, as amended, recites:

24. A system in a subscriber television system (STS), the system comprising:
a memory for storing logic;
a processor for executing the logic stored in memory;
logic configured to provide a plurality of media content instances to be displayed to a subscriber;
logic configured to provide at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances;
and
logic configured to enable at least one content restriction responsive to a reception of the at least one exclusive trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 24 is patentably distinct from the cited art. Therefore, *Wine* does not anticipate independent claim 24, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 24, as amended, is allowable over the cited references of record, dependent claims 25-30 (which depend from independent claim 24) are allowable as a matter of law for at least the reason that dependent claims 25-30 contain all the features of independent claim 24. Therefore, since dependent claims 25-30 are patentable over *Wine*, the rejection of claims 25-30 should be withdrawn and the claims allowed.

E. Claims 31-33

The Office Action rejects claims 31-33 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 31, as amended, recites:

31. A system in a subscriber television system (STS) client device, the system comprising:

- a memory for storing logic in the STS client device;
- a processor for executing the logic stored in memory in the STS client device;
- logic configured to provide a plurality of media content instances to be displayed to a subscriber;

logic configured to provide at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances;
and

logic configured to enable at least one content restriction responsive to a reception of the at least one exclusive trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 31 is patentably distinct from the cited art. Therefore, *Wine* does not anticipate independent claim 31, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 31, as amended, is allowable over the cited references of record, dependent claims 32 and 33 (which depend from independent claim 31) are allowable as a matter of law for at least the reason that dependent claims 32 and 33 contain all the features of independent claim 31. Therefore, since dependent claims 32 and 33 are patentable over *Wine*, the rejection of claims 32 and 33 should be withdrawn and the claims allowed.

F. Claims 34-36

The Office Action rejects claims 34-36 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 34, as amended, recites:

34. A system in a subscriber television system (STS) headend device, the system comprising:
- a memory for storing logic in the STS headend device;
 - a processor for executing the logic stored in memory in the STS headend device;
 - logic configured to provide a plurality of media content instances to be displayed to a subscriber;
 - logic configured to provide at least one trigger synchronized with a first media content instance of the plurality of media content instances; and
 - logic configured to enable at least one content restriction responsive to a reception of the at least one exclusive trigger, the at least one content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content***

instances, the particular media content instances associated with the at least one exclusive trigger.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 34 is patentably distinct from the cited art. Therefore, *Wine* does not anticipate independent claim 34, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 34, as amended, is allowable over the cited references of record, dependent claims 35 and 36 (which depend from independent claim 34) are allowable as a matter of law for at least the reason that dependent claims 35 and 36 contain all the features of independent claim 34. Therefore, since dependent claims 35 and 36 are patentable over *Wine*, the rejection of claims 35 and 36 should be withdrawn and the claims allowed.

G. Claims 37 and 38

The Office Action rejects claims 37 and 38 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wine, et al.* (U.S. Publication No. 2002/0004839). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 37, as amended, recites:

37. A system in a subscriber television system (STS) headend, the system comprising:
- a memory for storing logic in the STS headend;
 - a processor for executing the logic stored in memory in the STS headend;
 - logic configured to allow the STS headend to receive and distribute at least one transport stream to a plurality of client devices, the STS headend comprising an administrative content control module; and

logic configured to enable at least one exclusive trigger to be synchronized with an available insertion area in the at least one transport stream, the at least one exclusive trigger comprising at least one content restriction, the at least one content restriction enabling display of all media content instances except for at least one particular media content instance of the plurality of media content instances, the at least one particular media content instance associated with the at least one exclusive trigger.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 37 is patentably distinct from the cited art. Therefore, *Wine* does not anticipate independent claim 37, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 37, as amended, is allowable over the cited references of record, dependent claim 38 (which depends from independent claim 37) is allowable as a matter of law for at least the reason that dependent claim 38 contains all the features of independent claim 37. Therefore, since dependent claim 38 is patentable over *Wine*, the rejection of claim 38 should be withdrawn and the claim allowed.

V. Rejections Under 35 U.S.C. §103(a)

A. Claims 10-16

The Office Action rejects claim 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Birdwell, et al.* (U.S. Patent No. 6,108,706). The Office Action rejects claims 11-16 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Birdwell, et al.* (U.S. Patent No. 6,108,706), in further view of *Sahota* (U.S. Publication No. 2002/0010928). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

Independent claim 10, as amended, recites:

10. A method in a subscriber television system (STS), the method comprising the steps of:

providing a plurality of media content instances to be displayed to a subscriber by a client device;

providing at least one exclusive trigger synchronized with a first media content instance of the plurality of media content instances, the at least one exclusive trigger comprising at least one unique identifier;

enabling at least one content control module in the client device, the at least one content control module comprising a database of a plurality of values for a plurality of unique identifiers, the plurality of values being individually matched with a corresponding content restriction, the content restriction enabling display of all media content instances except for particular media content instances of the plurality of media content instances, the particular media content instances associated with the at least one exclusive trigger;

receiving the at least one exclusive trigger at the client device;

interpreting a value of the at least one exclusive trigger by the at least one content control module; and

enabling the at least one content control module to reference the database with the value and determine at least one enabled content restriction.

(Emphasis added).

For similar reasons set forth for claim 1, Applicant respectfully submits that claim 10 is patentably distinct from *Wine*.

Additionally, with regard to the rejection of claim 10, *Birdwell* and *Sahota* do not make up for the deficiencies of *Wine* noted above. Therefore, claim 10 is considered patentable over any combination of these documents.

For at least the reason that independent claim 10 is allowable over the cited references of record, dependent claims 11-16 (which depend from independent claim 10) are allowable as a matter of law for at least the reason that dependent claims 11-16 contain all the features of

independent claim 10. Therefore, the rejection of claims 11-16 should be withdrawn and the claims allowed.

B. Claim 23

The Office Action rejects claim 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wine, et al.* (U.S. Publication No. 2002/0004839) in view of *Jeannin, et al.* (U.S. Publication No. 2002/0083469). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

For at least the reason that *Wine* does not disclose, teach or suggest the above emphasized features of independent claim 21, and *Jeannin* does not remedy the deficiencies, dependent claim 23 (which depends from independent claim 21) is allowable as a matter of law for at least the reason that dependent claim 23 contains all the features of independent claim 21. Therefore, the rejection of claim 23 should be withdrawn and the claim allowed.

VI. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 and 4-38 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/

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